

**REMARKS**

Claims 1, 2, 6, 7, 10, 11, 13 and 14 are pending in the application. Claims 5, 9 and 12 have been cancelled. Claims 1, 6 and 10 have been amended.

Claims 1-2, 5-7, 9-10 and 12-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,095,050 (Figov) in view of EP0782106 (Brand). Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Figov in view of Brand and further in view of U.S. Patent 6,138,566 (Sakamoto). These rejections are respectfully traversed. Applicant hereby requests reconsideration and allowance of the claims in view of the following arguments.

Regarding the obviousness rejection of independent claims 1, 6 and 10 based on Figov and Brand, these claims have been amended to incorporate the limitations of original dependent claims 5, 9, and 12, respectively, to recite that the particular area to which an image protecting coating material is to be applied is determined based on image data. Dependent claims 5, 9 and 12 have consequently been cancelled. The recited “image data” is the image data to be printed.

Figov discloses using a computer to control placement of a coating over an image 44 (see, Figov at col. 3:52-55). However, Figov teaches only *over which area* of a print a coating system 50 places a layer of lacquer. Figov does not disclose that coating system 50 is controlled based on *image data* that has been used for the formation of the image 44, as claimed. See, e.g., Figov at col. 3:57-64. Figov is silent regarding how the computer control of its coating system 50 determines which part(s) of the print to coat.

It is contended in the Office Action that Figov discloses this claimed feature of original dependent claims 5, 9 and 12. However, the Office Action is incorrect. The Examiner has erroneously interpreted Figov’s description that a coating is placed on its image 44 by computer

control as meaning that Figov's coating system 50 is controlled using image data used to form image 44. There is no support in Figov for such an interpretation, so it cannot be used as a basis for an obviousness rejection.

The Brand reference does not teach or suggest applying a protective coating material based on image data either. Brand relates to an ink-jet printer used to form a mail stamp. Applicant further points out Brand teaches objects to be stamped by its mail stamp, such as letters, are not conveyed as they are being printed or coated, as are the print sheets of the claimed invention. Rather, in Brand, a number of nozzles needed to form a mail stamp at a fixed position on the object are provided. Thus, Brand's technique is very different from that of the present invention, and so does not suggest the claimed method or apparatus.

Neither Figov nor Brand teaches or suggests amended claim 1's step of determining a particular area to be coated based on image data forming an image on a print, or amended claim 6's area determining means for determining a particular area to be coated based on image data forming an image, or amended claim 10's area determining means for recognizing an image area from image data and determining a particular area to be coated to coincide with the image area. Therefore, any combination of Figov and Brand, however made, would still be missing these important claimed features, and it would not have been obvious to add these features to any Figov/Brand combination.

Consequently, amended independent claims 1, 6 and 10 are patentable, as are claims 2, 7, 13 and 14, which depend from claims 1, 6 and 10, respectively.

Regarding the obviousness rejection of dependent claim 11 based on Figov, Brand and Sakamoto, the Sakamoto reference does not teach or suggest the recited area determining means of claim 10, from which claim 11 depends, missing from Figov and Brand. Therefore, any

combination of Figov, Brand and Sakamoto, however made, would be missing this important claimed feature, and it would not have been obvious to add this feature to any Figov/Brand/Sakamoto combination.

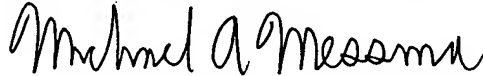
Consequently, claim 11 is patentable.

Thus, it is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Michael A. Messina

Registration No. 33,424

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 MAM:llg  
Facsimile: 202.756.8087  
**Date: June 17, 2006**

**Please recognize our Customer No. 20277  
as our correspondence address.**